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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,536	03/29/2004	Charles R. Slater	SYN-034 C2	2281
7590	01/24/2006		EXAMINER	
Gordon & Jacobson, P.C. 65 Woods End Road Stamford, CT 06905			GILBERT, SAMUEL G	
			ART UNIT	PAPER NUMBER
			3735	

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/811,536	SLATER ET AL.
	Examiner Samuel G. Gilbert	Art Unit 3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 31 October 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 21-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 21-33 is/are rejected.
- 7) Claim(s) 34 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claim 34 is objected to because of the following informalities: Claim 34 is written as being dependent on itself which is improper. Appropriate correction is required.

Claim 34 will not be considered on the merits because the examiner is unable to determine the scope of the claim.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21 and 24-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not set forth the metes and bounds of "means for selectively reconfiguring a marker". It is unclear to the examiner what the applicant is considering the "means". Also, the term "reconfiguring" does not appear in the applicant's specification which provides additional uncertainty to the metes and bounds of the applicant's claims because it is unclear what structure is required to perform the function of "selectively reconfiguring".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 28-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Cutrer(6,503,186).

The applicant's attention is invited to Figures 7a through 7d and column 8 line 21 through column 9 line 48. It is the examiner's position that the seeds are capable of being assembled just prior to implantation, as claimed. The use of different isotopes would provide seeds having different half lives. The total amount of radiation is varied by the number of radioactive elements included in the seed. Figures 7a-7d show markers having different lengths, size and shape. The size of two markers is different than three markers. The length of three markers positioned next to each other, 7a, is shorter than three spaced markers, 7c. Further, the shape of the markers in figure 7b is different than the shape of figure 7d.

Claims 28-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Robertson (6,099,458). Robertson teaches a plurality of seeds as shown in Figures 3

and 4. The seed in figure three has a short marker element –13- and the seed in figure 4 has a long marker –42--. The short marker is indicative of a higher radioactivity and the longer rod is indicative of less radioactivity due to the different amount of sources –31- and –41- in the respective seeds. Further, it is the examiner's position that the seeds are capable of being assembled just prior to implantation as claimed. The use of different isotopes would provide seeds having different half lives. The total amount of radiation is varied by the number of radioactive elements included in the seed.

Regarding the applicant's arguments that Robertson teaches remote manufacturing and then shipping to the medical center. It is the examiner's position that "by a physician just prior to insertion of the seed" is a product by process limitation and does not impart any structural difference between the seeds of Robertson and the claimed seeds. Further, "just prior to implantation" is a relative term and is not limited by any special definition and therefore can include the time of manufacturing of the seed. Further, manufacture by a physician is a method step limitation that does not provide any structural limitation to the claim. Finally, the structure of Robertson must only be capable of meeting these limitations to anticipate the claims and it is not required that Robertson actually set forth the steps/functional language as claimed. It is the examiner's position that the seeds of Robertson are capable of being assembled as taught by the physician in the medical facility, if the appropriate equipment was available. The applicant may want to consider method of making claims to cover these limitations.

The length and size of the markers shown in figures 3 and 4 are different.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,712,752. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are obvious modifications in the scope of the claims.

Claims 21-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,482,143. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are obvious modifications in the scope of the claims. Regarding the applicant's arguments set forth on page 8 of their response the examiner points to claims 23-30 which teach a seed as claimed in at least some of the claims set forth in this application.

Claims 21-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,200,258. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are obvious modifications in the scope of the claims. The examiner believes that the structure claimed provides the required structure, first and second markers and a seed having a preformed bore. The seed is capable of being reconfigured as claimed or formed just prior to implantation as claimed.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Gilbert whose telephone number is 571-272-4725. The examiner can normally be reached on Monday-Friday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ali Imam can be reached on 571-272-4737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Samuel G. Gilbert  
Primary Examiner  
Art Unit 3735

sgg